



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/051,395	05/08/98	MATHISON	024916-006

HM11/1109
BURNS DOANE SWECKER & MATHIS
PO BOX 1404
ALEXANDRIA VA 22313-1404

EXAMINER
JAMEISON, F

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 11/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/051,395

Applicant(s)

Mathison, et al.

Examiner

Fabian A. Jameison

Group Art Unit

1654



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1654

Election/Restriction

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1, and 37 CFR 1.475.

In accordance with 37 CFR 1.475 and 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-15, drawn to peptides of the formula R1-X1-X2-R2, and a method for preventing an anaphylactic reaction in mammals.

Group II, claim(s) 16, drawn to a method for preventing or reducing endotoxic reaction in a mammal.

Group III, claim(s) 17 and 18, drawn to a method for treating an inflammatory disorder, and inflammatory conditions.

Group IV, claim(s) 19, drawn to an antibody which recognizes a peptide epitope.

Group V, claim(s) 20, drawn to an immunoassay employing an antibody for a peptide epitope.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under 37 CFR 1.475 and 1.499, they lack the same or corresponding special technical features for the following reasons: The inventions of Group I concern peptides of different sequences and lengths. Groups III-IV are drawn to methods for treating various disorders, such as, endotoxic

Art Unit: 1654

reaction, inflammatory reaction, and specific disorders, such as, rheumatic and bowel disorders. The difference between the inventions is that the etiology of the diseased condition is different, making them amenable to treatment by different methods, such as, by the application of non-steroidal anti-inflammatory drugs. The invention of Group IV and V are different because the antibody used in the immunoassay in Group V could be used to identify any peptide epitope of either SGP-T or SGP-S. The number of potential peptides and antibodies meeting this requirement requires accessing multiple databases, due to their different classifications, and would constitute an unreasonable burden of search.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Art Unit: 1654

A) Sequence ID NO: 8

B) Sequence ID NO: 3

C) Sequence ID NO: 4

D) Sequence ID NO: 6

E) Sequence ID NO: 9

F) Phe-Glu-Gly

G) Phe-Glu-sarcosine

H) Sequence ID NO: 1

Applicant is required, in reply to this action, to elect a single species ^{within the elected Group} to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

Art Unit: 1654

Claim 5 corresponds to species A-D. Claim 6 corresponds to species E-G, and claim 11 corresponds to specie H.

The following claim(s) are generic: 1-4, 7-10, and 12-20

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The species all represent patentably distinct peptides, because they are all structurally different.

7. A telephone call was made to Ms Teresa Stanek Rea on 11/3/98 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fabian Jameison whose telephone number is (703) 305-0509. The examiner can

Art Unit: 1654


normally be reached Monday through Friday from 7:00 A.M. to 4:30 P.M. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner, Cecilia Tsang, may be reached at 703-308-0254. Papers relating to this application may be submitted to Technology Centre 1600 by facsimile. Papers should be sent via the PTO fax centre at 703-305-7401. The faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Fabian A. Jameison, Ph.D.

Patent Examiner

Art Unit 1654

November 2, 1998.


Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600